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### REMARKS

The undersigned thanks Examiner Brown for the interview conducted on February 28, 2006, where agreement was reached all rejections under 35 U.S.C. 112, 2<sup>nd</sup> paragraph were overcome, subject to the foregoing amendment and the following remarks.

Claims 1-66 were pending prior to amendment. Claims 1 has been amended to clarify the claimed subject matter. No new matter has been added.

#### Rejections under 35 U.S.C. § 112, 2<sup>nd</sup> ¶

Claims 1-66 stand rejected under 35 U.S.C. 112, 2<sup>nd</sup> paragraph for allegedly being indefinite. Claim 1 has been amended and thus obviates the contentions.

#### Rejections under 35 U.S.C. § 102(e)

Claims 1-4, 6-8, 10, 11, 13-21 and 23-26 stand rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent No. 6,507,865 to Hanson et al. ("Hanson"). Applicant respectfully traverses the rejections and their underlying rationale.

Contrary to the allegation stated in the Office Action, Hanson fails to anticipate claim 1 since Hanson does not teach each and every element as recited in the claim. For example, Hanson does not teach or suggest the following elements as recited in claim 1:

*distributing over the computer network to one or more users of the computer network a modular computer program that displays a stream of dynamic pricing information collected from a plurality of sources on the computer network;*

*presenting to the one or more users of the modular computer program an interactive visual indication of a user-attractive resource available on the computer network, the user-attractive resource providing an incentive, independent of the dynamic pricing information, to use the modular computer program, wherein the interactive visual indication of the user-attractive resource is visually embedded within the stream of dynamic pricing information displayed by the modular computer program;*

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The Office Action does not allege that Hanson teaches the elements. In fact, the Office Action simply refuses to give patentable weight to the elements for the following reason without providing a valid legal basis that permits such refusal.

"The distributing and presenting steps of claim 1 do not limit the method in any way. The distributing step simply distributes a modular computer program, while the presenting step simply presents a visual indication of a user attractive resources. These steps do not contribute to the only outcome of the method which is communicating a subset of dynamic pricing information to a second user." *See*, Office Action of November 03, 2005, pg. 3.

However, distributing a modular computer program is a required limitation of claim 1 and must be given patentable weight. Since the modular computer program displays the dynamic pricing information, the modular program must be distributed to the users in order for the users to view and interact with the dynamic pricing information. Thus, the distributing step is clearly a required element of claim 1. Likewise, the user-attractive resources must be presented to the user in order for the user to interact with the distributed modular computer program. Therefore, the presenting step also is a required element of claim 1 and must also be given patentable weight. In addition, the Examiner is required to consider every word of the claim in making the art rejections. Specifically, 35 U.S.C. § 102 requires that the prior art cited teach each and every element of the claim. (MPEP § 2143.03).

**To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (Emphasis added.)**

Even if the Examiner believed that claim 1 is indefinite, as alleged in the rejection under 35 U.S.C. § 112, 2<sup>nd</sup> ¶, the Examiner is still required to consider each and every word of the claim.

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**A claim limitation which is considered indefinite cannot be disregarded.** If a claim is subject to more than one interpretation, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under 35 U.S.C. 112, second paragraph (see MPEP § 706.03(d)) and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984) (Claims on appeal were rejected on indefiniteness grounds only; the rejection was reversed and the case remanded to the examiner for consideration of pertinent prior art.). Compare *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970) (if no reasonably definite meaning can be ascribed to certain claim language, the claim is indefinite, not obvious) and *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions). (Emphasis added.)

Further, whether the above presented elements of claim 1 *arguendo* contribute only to the outcome of the method is not relevant under 35 U.S.C. § 102. Instead, such issue should only be raised under 35 U.S.C. § 101. (MPEP § 2106). Even then, the burden is on the Office to prove that the claim is *devoid* of any utility. Thus, the Office Action has no basis to arbitrarily refuse to give patentable weight to any of the claim elements.

Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101.

Therefore, by refusing to consider each and every element of the claim, the Office Action has failed to satisfy the burden of proof to show how Hanson allegedly anticipate claim 1 as required under 35 U.S.C. § 102(e). For at least these reasons, claim 1 is patentable over Hanson.

Claims 2-4, 6-8, 10, 11, 13-21 and 23-26 are likewise patentable over Hanson for at least the same reasons as set forth with respect to claim 1 above.

Rejections under 35 U.S.C. § 103(a)

Claims 1-4, 6-8, 10-15, 21, 22, 27-30, 32-36, 42, 43, 48-52, 54-58 and 64-66 stand rejected as allegedly being unpatentable over the combination of Hanson and Rudich, J.

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"Customized News" link-up, v14, n6, pg. 24-26. Applicant respectfully traverses the rejections and their underlying rationale.

As set forth above, Hanson fails to teach or suggest each and every element of claim 1. For example, Hanson fails to teach or suggest the elements of "distributing" and "presenting" as recited in claim 1 and presented above. In fact, the Office Action admits that "[i]f Hanson could be construed to lack anything, it would be embedding the user attractive resource within the stream of dynamic pricing information." See, Office Action of November 03, 2005, pg. 7, 1<sup>st</sup> ¶. The deficiency of Hanson is not alleviated by the addition of Rudich. Contrary to the Office Action's allegation, Rudich fails to teach or suggest the elements missing from Hanson. In contrast to claim 1, the cited portion in Rudich discloses a content push service of PointCast, which presents ot a user a scrolling headline represented by a clickable hyperlink. However, the hyperlink in Rudich is not an user-attractive resource that provide an incentive to the user, independent of the dynamic pricing information as recited in claim 1. The hyperlinked headline in Rudich does not provide any incentive for the user to use a modular computer program. Even if, arguendo, the headline could be construed as an user-attractive resource, Rudich still lacks the dynamic pricing information, which must be independent of the user-attractive resource. Therefore, the proposed combination of Hanson and Rudich fails to teach or suggest each and every element of claim 1.

In addition, there is no motivation to combine Hanson and Rudich. The Office Action alleges that "Hanson's dynamic stream of pricing information could be improved by adding Rudich's interactive feature...Thus, Rudich's interactive hyperlink could be used to allow customers to gain more detailed information about advertisements embedded within Hanson's customizable applet." See, Office Action of November 03, 2005, pg. 7, 2<sup>nd</sup> ¶. However, nothing in Rudich suggests such a combination would be desired. Further, such reasoning only goes to prove that the proposed combination would not result in the claimed subject matter of claim 1. For example, even if Hanson and Rudich could hypothetically be combined as suggested by the Office Action, the hyperlinked headline would provide information **dependent** on the advertisements embedded within Hanson's customizable applet. In contrast, claim 1 expressly

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recites *presenting to the one or more users of the modular computer program an interactive visual indication of a user-attractive resource available on the computer network, the user-attractive resource providing an incentive, independent of the dynamic pricing information.*

Therefore, the hyperlinked headline of Rudich cannot be construed as the user-attractive resource, and a person of ordinary skill in the art would not have been motivated to combine Hanson and Rudich.

Further, there is no expectation of success for the proposed combination of Hanson and Rudich since Rudich teaches away from Hanson. For example, Hanson teaches allowing multiple users to collaborate in creating a dynamic content. *See, Hanson*, Col. 4, l. 47-58. In contrast, Rudich teaches allowing each individual user to specify which content is to be delivered or “pushed” to the user based on the preferences of the user. *See, Rudich*, pg. 3, last line – pg. 4, 2<sup>nd</sup> ¶. Therefore, Rudich does not allow multiple users to collaborate in determining the content of the information “pushed” to the users, and Hanson’s collaborative environment will cease to function as intended.

For at least these reasons, claim 1 is patentable over the proposed combination of Hanson and Rudich. In addition, claims 2-4, 6-8, 10-15, 21, 22, 27-30, 32-36, 42, 43, 48-52, 54-58 and 64-66 are likewise patentable over the proposed combination of Hanson and Rudich for at least the reasons set forth with respect to claim 1 above.

Claims 5, 9, 16-20, 23-26, 31, 37-41, 44-47, 53 and 59-63 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the combination of Hanson, Rudich, and Official notice.

The Office Action admits “neither Hanson nor Rudich expressly teach a virtual private network” as recited in claims 5, 31, and 53. *See, Office Action of November 03, 2005*, pg. 8, last full ¶. Then the Office Action relies on Official Notice to allege that “it would have been obvious to one skilled in the art to implement a virtual private network as claimed in order to provide a secure collaboration environment. This would have been particularly desirable considering Hanson teaches using its collaboration method to transmit financial information.” *Id.* However, this line of reasoning is faulty for the following reasons. First, if a virtual private

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network was desirable for the collaboration method of Hanson, Hanson would have *expressly* disclosed the virtual private network. The fact that Hanson did not do so is evident that a virtual private network is *not obvious* or necessary in Hanson. Second, the financial information transmitted in Hanson is *not* private information, and thus there is no need to provide a secure collaboration environment as alleged by the Office Action. Third, at issue is not Hanson alone, but the combination of Hanson and Rudich. Since Rudich clearly teaches away from Hanson by expressly disclosing *individual* and *not collaborative* input method of specifying the content of the "pushed" information, it would not have been obvious to include a virtual private network in the proposed combination of Hanson and Rudich. Finally, the Office Action fails to provide adequate technical line of reasoning as required when taking Official Notice without documentary support. "If Official Notice is taken of a fact, unsupported by documentary evidence, the technical line of reasoning underlying a decision to take such notice must be clear and unmistakable." (MPEP § 2144.03 B.)

Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection).

Further, Official Notice should only been taken when the alleged "common knowledge" is capable of instant and unquestionable demonstration. And whenever the adequately traverse the rejections relied upon Official Notice, the Office has the burden of producing factual evidence to support the Official Notice. Applicant respectfully request proof that the missing element is so well known in context of the claim elements present in claims 5, 31, and 53, which includes claim elements of independent claims 1, 27, and 49. (MPEP § 2144.03.)

Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken

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by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

**If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.** See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

For at least these reasons, claims 5, 31, and 53 are patentable over the proposed combination of Hanson, Rudich, and Official Notice.

In regard to claim 9, the Office Action admits that "neither Hanson nor Rudich expressly teach an instant messaging system" as recited in claim 9. See, *Office Action of November 03, 2005*, pg. 8, last ¶ - pg. 9, 1<sup>st</sup> ¶. Then the Office Action relies on an inadequate technical line of reasoning to justify the Official Notice. As set forth with respect to claims 5, 31, and 53 above, Official Notice taken without evidentiary support must be supported by "clear and unmistakable" technical line of reasoning. In contrast to the requirement set forth in MPEP § 2144.03 B, the Office Action simply alleges that "at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art to implement this feature in connection with Hanson's method in order to provide immediate access to Hanson's email messages." *Id.* at pg. 9, 1<sup>st</sup> ¶. However, as admitted by the Office Action, Hanson *fails* to teach *distributing over the computer network to one or more users of the computer network a modular computer program that displays a stream of dynamic pricing information collected from a plurality of sources on the computer network* as recited in claim 1, which claim 9 depends from. Therefore, it cannot reasonably be argued that it would have been obvious to use instant messaging system to distribute the modular computer program as recited in claim 9. In addition, as set forth with respect to claims 5, 31 and 53, the Office is requested to supply factual evidence to support the

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Official Notice. For at least these reasons, claim 9 is patentable over the proposed combination of Hanson, Rudich, and Official Notice.

In regard to claims 16-20, 37-41 and 59-63, the Office Action admits that "neither Hanson nor Rudich expressly teach a user attractive resource selected from the group consisting of a contest, a reward program, a coupon, an advertisement or a multimedia presentation" as recited in claims 16-20, 37-41 and 59-63. *See, Office Action of November 03, 2005*, pg. 9, 2<sup>nd</sup> ¶. Then the Office action again relies upon an inadequate technical line of reasoning to allege that "it would have been obvious...to use these incentives to increase the effectiveness and appeal of the advertisements embedded within Hanson's customizable applet." *Id.* However, neither Hanson nor Rudich teaches or suggest anything remotely close to increasing the effectiveness and appeal of the advertisements embedded. In addition, Applicant has shown that neither Hanson nor Rudich teaches or suggest the user-attractive resource as recited in claims 16-20, 37-41 and 59-63. Therefore, there it cannot reasonably be argued that it would have been obvious to add such incentives to Hanson nor Rudich. In fact, the line of reasoning alleged by the Office Action comes directly from the Applicant's specification. *See, e.g., Applicant's Specification*, pg. 11, l. 14-15; and pg. 17, l. 5-8. Therefore, the Office Action is employing improper hindsight gleaned only from the Applicant. Further, as set forth with respect to claims 5, 31, 53, and 9, the Office is requested to provide factual evidence to support the Official Notice. For at least these reasons, claims 16-20, 37-41 and 59-63 are patentable over the proposed combination of Hanson, Rudich, and Official Notice.

In regard to claims 12, 33, and 55, Office Action admits that "neither Hanson nor Rudich expressly teach presenting the dynamic pricing information in predetermined taxonomy" as recited in claims 12, 33, and 55. *See, Office Action of November 03, 2005*, pg. 8, last ¶ - pg. 9, 2<sup>nd</sup> full ¶. And again, the Office Action relies upon an inadequate technical line of reasoning to support the Official Notice. The Office Action alleges that "it would have been obvious to use a taxonomy to organize the different levels of information presented by Hanson's customizable applet. This combination would provide a means for organizing different categories of pricing information." *Id.* However, neither Hanson nor Rudich teach or suggest that such motivation to



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combine. The fact that Hanson did not disclose or suggest using taxonomy is clear evidence that using Taxonomy in Hanson is not obvious, or that Hanson's teachings are not compatible with using Taxonomy, or both. Neither Hanson nor Rudich teaches or suggests the desire to organize different pricing information, thus the Office Action presumes too much by incorporating an element not taught or suggested by either reference. In addition, a taxonomy is not the only way to organize information and thus it is improper for the Office Action to suggest that using a taxonomy is well known and obvious. Further, as set forth with respect to claims 5, 31, 33, 53, 9, 16-20, 37-41 and 59-63, the Office is requested to produce factual evidence to support the Official Notice. For at least these reasons, claims 12, 33 and 55 are patentable over the proposed combination of Hanson, Rudich, and Official Notice.

In regard to claims 23-26 and 44-47, the Office Action admits that "neither Hanson nor Rudich expressly teach displaying one or more instances of the modular computer program concurrently, wherein the one or more instances are the same or different from one another" as recited in claims 23-26 and 44-47. *Id.* at 3<sup>rd</sup> full ¶. Then the Office Action alleges that the addition of the missing element would have been obvious because "arranging different and/or redundant messages in an email in inbox using one or more visual indications was old and well known...Therefore arranging Hanson's e-mailed applets according to a customary inbox would have been obvious modification...desiring to organize a plurality of Hanson's applets." *See, Office Action of November 03, 2005*, pg. 9, last ¶ - pg. 10, 1<sup>st</sup> ¶. However this line of reasoning is faulty and non-analogous to the claimed elements. Claims 23-26 and 44-47 do not recite displaying multiple instances of e-mails. The claims clearly recite that a plurality of instances of the modular computer program are presented to a user concurrently. Therefore presenting a plurality of e-mails concurrently is not the same, even if the modular programs are distributed via e-mail. In addition, Hanson does not teach distributing modular programs as set forth above with respect to claim 1. Therefore, the Office Action cannot reasonably allege that Hanson now teaches distributing modular programs via e-mail. Even if, *arguendo*, Hanson could be construed to teach sending modular programs via e-mail, Hanson does not teach or suggest displaying multiple instances of modular programs as recited in claims 23-26 and 44-47. Therefore, the

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Office Action again fails to provide adequate technical line of reasoning to support the Official Notice, and the Office is requested to provide factual evidence to support the Official Notice as set forth with respect to claims 5, 31, 33, 53, 9, 16-20, 37-41, 59-63, 23-26 and 44-47 above. For at least these reasons, claims 23-26 and 44-47 are patentable over the proposed combination of Hanson, Rudich, and Official Notice.

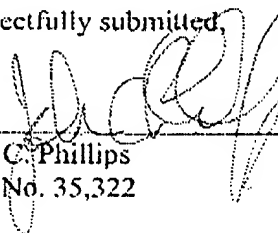
### Conclusion

It is believed that all of the pending claims have been addressed in this response. However, failure to address specific rejections, issue, or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this response should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Claims 1-66 are in the condition for allowance, and a notice to that effect is respectfully solicited. If the examiner has any questions regarding this response, the examiner is invited to telephone the undersigned at (858) 678-5070

Please apply \$450 for two months extension of time fee, and any other charges or credits to deposit account 06-1050

Respectfully submitted,



John C. Phillips  
Reg. No. 35,322

Date: April 3, 2006

Fish & Richardson P.C.  
12390 El Camino Real  
San Diego, California 92130  
Telephone: (858) 678-5070  
Facsimile: (858) 678-5099

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